1F/2800/B

TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.
IDS-14302/14

In Re Application Of: **Venegas, Jr.**

Serial No.	Filing Date	Examiner	Group Art Unit
09/829,033	**April 9, 2001**	**Sawhney**	**2875**

Invention: **LIGHTED STANCHION COVER**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:
March 19, 2003

Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

☐ is enclosed.

☐ has already been filed in this application.

The fee for filing this Appeal Brief is: **$160.00**

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☒ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is enclosed.

☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. **07-1180**
A duplicate copy of this sheet is enclosed.

Dated: **May 19, 2003**

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I certify that this document and fee is being deposited on 5/19/03 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

11/appeal brief S. Steptoe 5-29-03

In re application of: Venegas, Jr.

Serial No.: 09/829,033 Group No.: 2875

Filed: April 9, 2001 Examiner: Sawhney

For: LIGHTED STANCHION COVER

APPELLANT'S BRIEF UNDER 37 CFR §1.192

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Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Frank Venegas, Jr., Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 12 claims. Claim 12 has been allowed. Claims 1-11 are under appeal.

IV. Status of Amendments Filed Subsequent Final Rejection

An after-final amendment is being filed herewith to change the dependency of claim 8 from claim 1 to claim 7. The previous dependency was clearly in error since otherwise there is an antecedent basis problem.

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V. Concise Summary of the Invention

The present invention is directed toward providing a lighted stanchion cover for a stanchion that includes an elongated tubular body with a lighting assembly disposed within its exterior surface. In the preferred embodiment, the lighted stanchion cover provides the stanchion with illumination without sacrificing the protective barrier function of the stanchion (Specification, page 3, lines 13-17). A preferred embodiment of the lighted stanchion cover, according to the invention, includes an elongated tubular body with opposite ends, one end open and the other closed (Specification, page 3, lines 18-20). The interior cavity of the cover is dimensioned to receive the entire stanchion through its open end in slip fit engagement (Specification, page 3, lines 20-21). A lighting assembly, that includes a light and power source, is integrated within the body of the cover and is fashioned so not to interfere with reception of the stanchion into the cover (Specification, page 3, line 21 to page 4, line 2). In the preferred embodiment, the lighting assembly is designed to receive power from an external power source. A second embodiment has the lighting assembly designed to receive power from an internal power source (Specification, page 4, lines 3-5). Optionally, to improve power efficiency, an electronic circuit can be integrated into the lighting assembly for power management and control to ensure that electrical energy will only be expended under certain conditions as a method of energy conservation Preferably, a lighted cover will be fastened to the fixed surface by use of a conventional fastening means sufficient for such purpose (Specification, page 4, lines 6-11).

VI. Concise Statement of Issues Presented For Review

1. Are claims 1-8 unpatentable under 35 U.S.C. §103 over U.S. Patent No. 5,121,307 to Moore?

2. Are claims 9-11 unpatentable under 35 U.S.C. §103 over U.S. Patent No. 5,121,307 to Moore in view of U.S. Patent No. 4,819,135 to Padilla?

VII. Grouping of Claims for Each Ground of Rejection Which Appellant Contends

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Appellant believes the following groups of claims represent patentably distinct subject matter requiring separate consideration on appeal:

Group I: Claims 1-11, wherein claims 2-11 stand or fall with claim 1;

Group II: Claims 7, 8, 10 and 11, wherein claims 8, 10 and 11 stand or fall with claim 7; and

Group III: Claim 9.

VIII. Argument

A. Group I - Claims 1-11, wherein claims 2-11 stand or fall with claim 1.

Claims 1 stands rejected under 35 U.S.C. §103 over Moore, U.S. Patent No. 5,121,307. Claim 1 includes the limitation of a cover that receives a stanchion substantially in its entirety, such that the bottom (open) end of the cover is proximate to, or in contact with, a ground surface. This clearly distinguishes over the Moore reference.

The Moore patent is directed to a pole-mounted, self-contained, solar-powered strobe light utilizing ultraviolet rays from the sun (and moon) for charging its batteries and employing a cylindrical housing open at one end for fitting over the top of a vertically mounted pole. Batteries are insertable in the other end of the housing which are covered by a cap for closing this end of the housing. The cap has mounted on it a strobe light connected to the batteries and covered by a transparent magnifying lens (U.S. Patent No. 5,121,307, Abstract).

The housing is adapted only to fit over the top end an electric power or telephone pole (col. 2, lines 18-19). Clearly the cover of Moore could not extend down to a ground surface due to the wires and other obstacles that telephone and utility poles are designed to support. Given that obviousness cannot defeat a purpose for which a prior-art invention is intended, the rejection *prima facie* obviousness has not been established.

B. Group II: Claims 7, 8, 10 and 11, wherein claims 8, 10 and 11 stand or fall with claim 7.

Claim 7 includes the limitation that the elongated tubular body of claim 1 displays a message. This claim stands rejected under 35 U.S.C. §103 over Moore despite the fact that Moore does not teach or suggest such a limitation. Instead, the Examiner fabricates a new 'rule' that a limitation, even if positively recited, must 'solve a problem' or be there for a 'particular reason.' Appellant knows of no

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such rule. Moreover, since the device of Moore is used at a high altitude, particularly for helicopters or other low-flying aircraft, such that a message would not be visible. Obviousness cannot be established where there is no reasonable degree of success.

C. Group III: Claim 9.

Claims 9 stand rejected under 35 U.S.C. §103 over Moore in view of Padilla et al., U.S. Patent No. 4,819,135. The Examiner concedes that Moore does not disclose light-dispersing windows, a message displayed by a plurality of light sources, or light sources in the form of light-emitting diodes. The Examiner states that it would have been obvious to modify the lighting assembly of Moore with the tubular body taught by Padilla "for benefits and advantages of eye-catching displays and for traffic safety in dark." However, Appellant disagrees for several reasons. First, as discussed above, given that the cover of Moore is intended for tops of utility poles, and the like, at distances high above the ground, the desirability of a "eye-catching display" makes little practical sense. In addition, it is well settled that, in order to establish *prima facie* obviousness in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Appellant's claimed invention. There must be something *in the prior art* that suggests the proposed modification, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

Additionally, it is Appellant's contention that Padilla represents non-analogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in

considering his problem"); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). In this case, Padilla, being directed to a bicycle lighting device bears no relation whatsoever to the problem facing Moore, or Appellant.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: _____

Date: May 19, 2003

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APPENDIX A

CLAIMS ON APPEAL

1. A lighting assembly for use with a stanchion extending outwardly from a ground surface comprising:

an elongated tubular body having an open end and a closed end defining an interior cavity, the open end and the interior cavity of the elongated tubular body being dimensioned to receive the stanchion substantially entirely therein such that the open end is proximate to or in contact with the ground surface; and

a lighting assembly, having a light source interconnected to a power source, the light assembly being secured relative to the tubular body so that the light is visible exteriorly of the interior cavity.

2. The lighting assembly of claim 1 wherein the power source is external to the lighted stanchion cover.

3. The lighting assembly of claim 2 further includes an electronic circuit for power management and control.

4. The lighting assembly of claim 3 further including a light source receptacle for receiving a lamp.

5. The lighting assembly of claim 1 wherein the power source is a plurality of photovoltaic devices that are supported by the elongated tubular body.

6. The lighting assembly of claim 1 wherein the power source is a battery.

7. The elongated tubular body defined in claim 1 wherein the body displays a message.

8. The elongated tubular body defined in claim 1 wherein the message is stenciled letters or

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an image upon the body.

9. The elongated tubular body defined in claim 1 wherein the body includes one or more light dispersing windows.

10. The elongated tubular body of claim 7 wherein the message is displayed by a plurality of light sources supported by the thickness of the body.

11. The elongated tubular body of claim 10 wherein the plurality of light sources are light emitting diodes.